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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
33012/263/101

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on October 2, 2006

Signature

Typed or printed name Carolyn I. Erickson

Application Number	Filed
09/304,406	May 4, 199

First Named Inventor: Ralph E. Sipple et al.

Art Unit	Examiner
2623	H. Lonsberry

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☑ attorney or agent of record. Registration number 25,645

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Wayne A. Sivertson
Typed or printed name

612-331-1464
Telephone number

October 2, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 4 forms are submitted.

P A T E N T

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Ralph E. Sipple et al.

Serial No. : 09/304,406 Examiner: H. Lonsberry

Filed : May 4, 1999 Group Art Unit: 2623

For : WEB BASED VIDEO-ON-DEMAND TRANSACTION SERVER

Docket No. : 33012/263/101

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE UNDER 37 C.F.R. 1.8
I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an enveloped addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 2nd day of October, 2006

By: _____
Carolyn I. Erickson

Sir:

The Examiner has rejected claims 1, 6, and 11-24 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,583,561, issued to Baker et al (hereinafter referred to as "Baker") in view of U.S. Patent No. 5,132,992, issued to Yurt et al. (hereinafter referred to as "Yurt"). This rejection should be reversed for failure of the Examiner to present a *prima facie* case of obviousness as specified by MPEP 2143 for the reasons provided below.

Applicants' invention, as disclosed and claimed, is a video on demand system wherein a first computer (i.e., transaction server)

provides the control interface with the user and "spools" a requested video program into temporary storage and one of a plurality of second computers is assigned by the first computer to "stream" the requested video program to the user. The advantages of this architecture are discussed at length within Applicants' specification. In short, the first computer is optimized about its many diverse functions and the plurality of second computers are optimized about the sole function of "streaming" video from temporary storage to users as assigned. This architecture requires a given video program to be "handled" by both the first computer (i.e., spooled) and by one of the second computers (i.e., streamed). This basic architecture is not found in the prior art of record and certainly not found in Baker and/or Yurt.

The lack of this unique architecture within the prior art is evidenced in the Examiner's rejections. With regard to claim 1, for example, the Examiner admits:

> Baker fails to disclose a plurality of video servers directly coupled to the transaction server and temporary memory directly coupled to the video server and the transaction server.

Apparently attempting to show motivation for the alleged combination of Baker with Yurt, the Examiner then goes on to state:

> Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Baker to utilize the direct connection to the transaction server as take (sic) by Baker, for the advantage of spreading out the load generated by a number of users by utilizing a plurality of video servers.

To the extent understandable, this statement is inadequate as a matter of law, because it is inconsistent with the specific teachings of the

references.

Baker, column 6, lines 11-16, provides that the alleged combination is specifically inconsistent with the object of Baker stating:

> Yet another object of this invention is to utilize a high-performance enterprise server computer system and asynchronous transfer mode communication devices to selectively distribute encoded, compressed, digital video data in real-time over a public switched integrated-services network to a large number of remotely located viewer sites.

In short, not only does Baker not desire "the advantage of spreading out the load generated by a number of users by utilizing a plurality of video servers" as alleged by the Examiner, Baker actually teaches the advantages of using a large mainframe computer system instead, to provide virtually all video on demand functions. The system taught by Baker uses the same mainframe computer to access, "spool", and "stream" the requested program without any anticipated need for "spreading out the load" as alleged by the Examiner.

Further with regard to claim 1, for example, claim element c requires that the "transaction server spools said different video on demand programs from said data base storage to said temporary video storage memory" and claim element d requires that "said plurality of video servers....stream said spooled different video on demand programs from said temporary video storage memory to said plurality of subscriber receivers". In other words, claim 1 requires that "spooling" is accomplished by the "transaction server" and that "streaming" is accomplished by the "plurality of video servers".

In Baker, both of these functions are accomplished by the same

entity, "video server 12". In the claimed invention, both the "transaction server" (i.e., "spooling") and the "plurality of video servers" (i.e., "streaming") handle video information. In Baker, all video information is handled by "video server 12". The Examiner continues to read the claimed "transaction server" element on to "control server" 54 of Baker. Though both the claimed "transaction server" and "control server" 54 of Baker can handle subscriber requests, "control server" 54 of Baker cannot handle video data.

Baker specifically disclaims that "control server" 54 handles any video. Column 10, lines 50-60, wherein Baker states in part:

> Control server 54 may....coordinate the access of the multiple Video Servers to the Video Library.....

Not only does Baker not disclose that "control server" 54 ever handles the video programming data, it specifically states that it does not.

This distinction was previously described to the Examiner in detail. In a prior response to Applicants' previous arguments, the Examiner earlier stated:

> Likewise, claim 1 requires that the server spools the programs from the database storage to video storage memory, there is no mention of direct access in claims 1 and 6 as argued by application.

It was exceedingly difficult to understand why the Examiner equated "direct coupling" with the function of "spooling". Nevertheless, independent claims 1, 6, 11, 16, and 21 were previously amended to address this concern of the Examiner, even if not well founded.

Therefore, the rejection of claim 1, and all claims depending therefrom, should be reversed for failure of the Examiner to make any

of the three showings required by MPEP 2143.

In rejecting independent claims 6, 11, 16, and 21 the Examiner makes a similar clearly erroneous finding of fact.

Respectfully submitted,

Ralph E. Sipple et al.

By their attorney

Date Oct 2, 2006

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